



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,784	10/16/2001	Toshiyasu Ito	04208.0112	8751

22852 7590 04/12/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

FIGUEROA, FELIX O

ART UNIT PAPER NUMBER

2833

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

**Office Action Summary**

Application No.

09/869,784

Applicant(s)

ITO ET AL.

Examiner

Felix O. Figueroa

Art Unit

2833

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/21/2006</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/21/2006 has been entered.

### ***Information Disclosure Statement***

The information disclosure statement filed 02/21/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 as follows:

37 CFR 1.98(a)(1) U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents.

37 CFR 1.98(b)(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

It has been placed in the application file, but some of the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

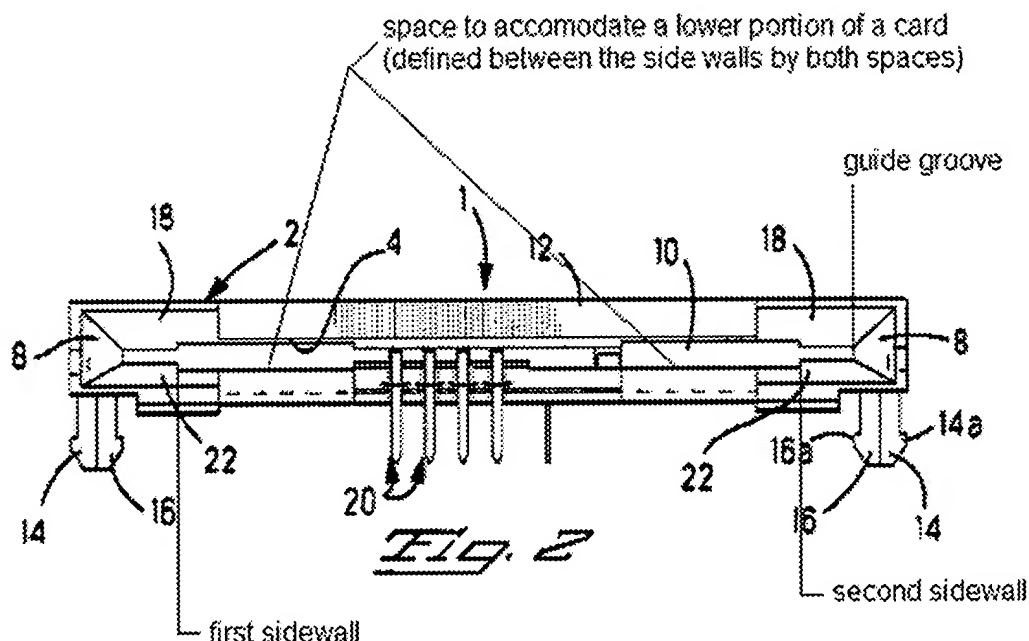
Claims 1, 2, 5-8, 11, 12, 14-22 and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Asakawa (US 6,135,809).

Asakawa discloses a card connector configured to hold a first card and configured to hold a second card, and comprising: a pair of guide grooves (see following figure) formed on both sidewalls of a connector housing (2); and first and second sidewalls (see following figure), and a base plate with a plurality of contact terminals (20) arranged in the base plate to couple with contact of a bottom surface of a card. Asakawa also discloses a first space defined between the guide grooves, and a second space defined by the sidewalls; wherein no portion of the base extends into the second space; the second space (see following figure) located below the first space, and the second space configured to accommodate a lower portion of a first card.

Please note that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. In this case, Asakawa discloses a second space that can accommodate the lower portion of an appropriate first card. Additionally, it is noted that recitations of the intended use of the

Art Unit: 2833

claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).



Please note that the space is defined by both spaces as shown in the earlier presented figure.

Regarding claims 2, 12 and 22, Asakawa discloses the sidewalls formed at such locations that they can guide the side surfaces of a lower body portion of a first card (C).

Regarding claims 5, 6, 15, 25 and 26, Asakawa discloses a housing top plate that forms upper walls of the guide grooves is formed with an opening / a recess (adjacent 12) having a width larger than a lower body portion of a first card, i.e. a least the same size as the separation between the side walls.

Regarding claims 7, 8, 11, 17, 18, 27 and 28, please note that the terminals 50 work as a braking piece.

Regarding claims 14, 16, 19, 20, 29 and 30, Asakawa discloses a housing top plate that forms upper walls of the pair of guide grooves is formed with an opening having a width larger than that of the lower body portion of the first card; and the housing top plate forming upper walls of said pair of guide grooves being formed with a recess having a width larger than that of the lower body portion of said first card and receding in the height direction.

Claims 1, 2, 5-8, 11, 12, 14-22 and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hakoziaki (US 6,234,845).

Hakoziaki discloses a card connector comprising: a pair of guide grooves (33,34) formed on first and second sidewalls (not labeled) of a connector housing (30); and a base plate (seen at top of figure 1) with a plurality of contact terminals (37) arranged in the base plate to couple with contact of a bottom surface of a card. Hakoziaki also discloses a first space defined between the guide grooves, and a second space defined by the sidewalls; wherein no portion of the base extends into the second space; the second space located below the first space, and the second space configure to accommodate a lower portion of a first card. Please note that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. In this case, Hakoziaki discloses a second space that can accommodate the lower portion of an appropriate first card. Additionally, it is noted that

recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 2, 12 and 22, Hakozaiki discloses the sidewalls formed at such locations that they can guide the side surfaces of a lower body portion of a first card.

Regarding claims 5, 6, 15, 25 and 26, Hakozaiki discloses a housing top plate that forms upper walls of the guide grooves is formed with an opening / a recess having a width larger than a lower body portion of a first card, i.e. a least the same size as the separation between the side walls.

Regarding claims 7, 8, 11, 17, 18, 27 and 28, please note that at least one of the terminals work as a braking piece.

Regarding claims 14, 16, 19, 20, 29 and 30, Hakozaiki discloses a housing top plate that forms upper walls of the pair of guide grooves being formed with an opening having a width larger than that of a lower body portion of a first card; and the housing top plate forming upper walls of said pair of guide grooves being formed with a recess having a width larger than that of the lower body portion of said first card and receding in the height direction.

Regarding claims 31-33, Hakozaiki discloses that no portion of the base extends into the second space between the first and second sidewalls.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 10, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakawa in view of Horie (US 6,231,360).

Asakawa discloses substantially the claimed invention except for the eject mechanism. Horie teaches a card connector having an ejector mechanism (11) to help withdraw a card from the socket. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to from the card connector of Asakawa having an ejector mechanism, as taught by Horie, to help withdraw a card from the socket.

Regarding claim 4, Asakawa discloses the braking piece secure to a position which is far part of the guide groove.

Claims 3, 4, 9, 10, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakozaiki in view of Horie (US 6,231,360).

Hakozaiki discloses substantially the claimed invention except for the eject mechanism. Horie teaches a card connector having an ejector mechanism (11) to help withdraw a card from the socket. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to from the card connector of Asakawa having an ejector mechanism, as taught by Horie, to help withdraw a card from the socket.



Regarding claim 4, Hakozaki discloses the braking piece secure to a position which is far part of the guide groove.

### ***Response to Arguments***

Applicant's arguments filed 02/21/2006 have been fully considered but they are not persuasive.

In response to Applicant's arguments that Asakawa does not teach a second space "defined by said first and second side walls", please note that it has been held that an indefinite article "a" or "an" in patent parlance carries the meaning of "one or more" in open-ended claims containing the transitional phrase "comprising". Unless the claim is specific as to the number of elements, the article "a" receive a singular interpretation only in rare circumstances when the patentee evinces a clear intent to so limit the article. See *Scanner Technologies v. ICOS Vision Systems corp.*, 70 USPQ2D 1900 (CA FC 2004). Additionally, please note that the fact that the partition 28 sit between the first and second side wall does not means that it "extends into" the second space (as defined by both spaces as shown above). Accordingly, partitions 28 do not extend into the space itself, as defined.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone

Art Unit: 2833

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Felix O. Figueroa  
Art Unit 2833